

## **REMARKS**

Claims 1-65 are pending in the present application.<sup>1</sup>

Claims 1-65 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103 as being obvious over, United States Patent 4,834,735, entitled “High Density Absorbent Members Having Lower Density And Lower Basis Weight Acquisition Zones”, to Alemany *et al.* (“Alemany”). These grounds of rejection are respectfully traversed.

### **Rejections under 35 U.S.C. §§ 102(e) and 103**

The Examiner characterizes Alemany as disclosing an absorbent article, and by description, a method of designing an absorbent article, comprising a topsheet, a backsheet, and absorbent core between the topsheet and backsheet. The Examiner also characterizes Alemany as teaching “similar” materials for the core, topsheet, and backsheet. On this basis, the Examiner concludes that Alemany meets the structural requirements of the claims.

In the prior Amendment, claims 1, 7, 13, and 19 were each amended to recite “the absorbent core and insult point having a substantially equal total basis weight.” As discussed in more detail below, Alemany does not disclose or teach, nor is it inherent therein, an absorbent article in which the absorbent core and insult point having a substantially equal total basis weight.

In the “Response to Arguments” (page 2 of the present Office Action) the Examiner states that:

1. Applicant's arguments filed 12/5/07 have been fully considered and they are not [sic] partially persuasive. Applicant argues Alemany does not disclose an absorbent where the absorbent core and insult point are identical structures. However, this feature is not claimed. What is required by the claims is the absorbent core have a basis weight substantially equal to the basis weight of the insult point. Applicant argues Alemany teaches a acquisition zone with a lower basis weight from the storage zone. The term ‘substantially equal’ does not require the zones to be identical, but allows for some differences in basis weights between the zones.(emphasis added.)

Applicant respectfully disagrees with the foregoing interpretation of what Applicant argued in the prior amendment, and with the inference that Alemany discloses an absorbent article in which the basis weight of the absorbent core and insult point are “substantially equal”

as recited in the claims.

I. In re Best and In re Fitzgerald

In the first instance, Applicant's argument may have been interpreted slightly out of context. Specifically, Applicant does not argue that the amended claims are patentable *because* the article disclosed in Alemany is not "identical" to the claimed article (which the Examiner correctly notes is not recited in the claims). Instead, Applicant argues that the article in Alemany is not "identical or substantially identical" to the claimed article for purposes of the application of the rule set out in In re Best regarding whether a limitation is inherently disclosed in the prior art, i.e.:

A prima facie case of either anticipation or obviousness can only be established when the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). (emphasis added)

Thus, if Alemany does not disclose an article in which the absorbent core and the insult point have a "substantially equal" basis weight, then the article in Alemany is neither "identical" nor "substantially identical." As a result, the claimed "substantially equal" basis weight cannot be "inherently" disclosed in Alemany, according to In re Best.

As will be discussed more below in section II, the absorbent core and insult point in Alemany do not have the claimed "substantially equal" basis weight, and the structure in Alemany is therefore not "identical or substantially identical" to the claimed invention.

Accordingly, Applicant's argument is that, under In re Best, a prima facie showing that Alemany inherently discloses an absorbent article in which the absorbent core and the insult point have a "substantially equal" basis weight has not been made. Consequently, the claims are patentable over Alemany in this regard.

In re Fitzgerald is cited by the Examiner for the proposition that when a prior art reference discloses *all* of the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, it is proper to shift the burden of proof to applicant to show that the prior art would not have the claimed property or function.

However, In re Fitzgerald requires that the prior art reference must first disclose *all* of the

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<sup>1</sup> The Examiner has rejected claims 1-69-- but there only 65 claims are pending.

limitations of the claim except for the recited property or function, before the rule can be applied to shift the burden of proof to the Applicant. Consequently, if the prior art reference does not disclose **all** of the limitations of the claim except for the property or function, then the rule does not apply. In this case, Alemany does not disclose or teach that the absorbent core and the insult point have a “substantially equal” basis weight.

Referring to page 2 of the Office Action, second to last sentence, it is stated that “In this case the basis for shifting the burden of proof is that Alemany discloses **similar materials and construction** as the claimed invention.” However, this also is not the proper test to make a prima facie case of anticipation or obviousness. Instead, as quoted above, In re Best states that a prima facie case of anticipation or obviousness “can only be established when the claimed and prior art products are identical or substantially identical in structure or composition.” (emphasis added)

The Examiner argues only that Alemany discloses “similar” materials and construction, whereas In re Best requires “identical or substantially identical” materials and construction. Therefore, a prima facie case of anticipation or obviousness of the claims over Alemany has not been established by the Examiner under the test set out in In re Best.

Additionally, as a related point, if the limitation in question is not disclosed, or inherent, in Alemany, then In re Fitzgerald also does not apply to shift the burden of proof to the Applicant-- since “all” of the limitations except the property or function are not disclosed.

As a result, the final rejection should be withdrawn and Applicant’s arguments in regard to the differences in the core and insult point construction in Alemany, as compared to the claimed article, should be reconsidered. These arguments are discussed in detail below.

## II. The Structure in Alemany is Not “Substantially Identical”

Applicant has two points to make in this regard. First, Alemany contains no disclosure or teaching that the article described therein has an absorbent core and an insult point which have a “substantially equal” basis weight. Second, Alemany expressly teaches just the opposite.

Claims 1, 7, 13, and 19, as previously amended, each require that the absorbent core and insult point have a “substantially equal” total basis weight.

Applicant concedes that a “substantially equal” basis weight does not require an “identical” basis weight. However, Alemany clearly fails meet the “substantially equal” limitation, not only because there is no express disclosure or teaching of this limitation, but also

because Alemany expressly teaches the opposite. Alemany expressly teaches that the basis weight of the acquisition zone 56 must be lower than the basis weight of the storage zone 48. This can be found in column 12, lines 11-16, wherein Alemany states that “the acquisition zone 56 must have both a relatively lower average density and lower average basis weight per unit area than the storage zone 48 to establish the preferred capillary force gradient between them.” (emphasis added.)

This clearly and unambiguously teaches away from the absorbent article as presently claimed wherein the absorbent core and insult point have a “substantially equal” basis weight.

If the basis weight in Alemany were “substantially equal” as argued by the Examiner, then the preferred capillary force gradient between them may not be established. This would be directly contrary to the express teaching in Alemany in regard to the characteristics of that absorbent article described therein.

Only Applicant’s specification discloses that the absorbent core and the insult point should have the same basis weight. Therefore, to characterize Alemany as teaching this limitation, in direct contradiction of the above-quoted portions of Alemany, would be using Applicant’s own disclosure as a guide, which necessarily constitutes the improper use of hindsight.

The interpretation of “substantially equal” basis weight for the absorbent core and insult point may well leave room for some difference in basis weight between the two. However, the interpretation of that limitation surely cannot encompass the article in Alemany, in which it is specifically described that the insult point must have a lower basis weight than the absorbent core. Thus, Alemany does not disclose or teach an absorbent article in which the absorbent core and the insult point have a “substantially equal” basis weight. Consequently, under In re Best, Alemany does not disclose “identical or substantially identical” structure, which means that this limitation also is not “inherent” in Alemany. This also necessarily precludes that applicability of In re Fitzgerald in the context asserted by the Examiner.

Therefore, claims 1-65 are patentable over Alemany.

As an additional point, the Examiner has further characterized Alemany as recognizing the absorbent capacity as a result effective variable of the materials used to make up the core. Applicant respectfully submits that Alemany does not contain any disclosure or teaching which would indicate a recognition of the leakage performance index as presently claimed as a result

effective variable. The Examiner has not pointed out any portion of the Alemany that would unambiguously indicate any such recognition.

The claimed leakage performance index is a function of at least three variables, and in certain embodiments five variables, i.e., surrounds efficiency, third void strikethrough, total capacity of the article, percent utilization of the absorbent core upon insult, and front pad absorbency under load. The absorbency capacity is only one of the four variables comprising the leakage performance index.

Alemany does not (i) identify the other four variables comprising the leakage performance index, (ii) suggest which of the numerous variables affect the leakage performance index, or (iii) suggest which experiments are required to determine the leakage performance index. Consequently, the experimentation needed to identify the five variables that comprise the leakage performance index, and then to derive the relationship among them, would require much more than routine experimentation.

Applicant also notes that independent claims 25, 38, and 63-65 have not been individually addressed, other than in very general arguments that Alemany “recognizes the absorbent capacity is a result effective variable of the materials used to makeup core.”

However, each of these independent claims contain numerous specific limitations which are not even specifically addressed by the Examiner. Each of the various limitations in these claims are not explicitly or impliedly encompassed within simply the aforementioned quote regarding the absorbent capacity being recognized as “a result effective variable.”

More particularly, for example, each of independent claims 25, 38, and 65 are drawn to specific methods for designing absorbent articles. Each of the limitations recited in these claims are not disclosed, inherent, or taught in Alemany.

### **CONCLUSIONS**

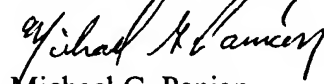
For all of the reasons set forth in more detail above, Applicant respectfully submits that Alemany does not disclose or teach, nor is it inherent therein, at least the following limitations recited in independent claims 1, 7, 13 and 19:

- an absorbent article having an absorbent core with a basis weight substantially equal to the basis weight of the insult point; and
- a leakage performance index as a result effective variable.

Moreover, further in view of the reasons given above, claims 25, 38, and 63-65 are also believed to be patentable over Alemany.

Therefore, reconsideration and allowance of claims 1-65 are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael G. Panian", written over the printed name.

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